

156-102
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of)
John Richard BERGAN)
Serial No. 09/558,060) Examiner: B. To
Filed: April 26, 2000) Group Art Unit: 2172
For: DATA CHECKER APPARATUS) March 14, 2006
AND METHOD)

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT

Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

03/15/2006 MBEYENE2 00000129 09550060

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200.00 OP

The fee for this request is enclosed.

Reconsideration of the determination of patent term extension under 35 U.S.C.

154(b) (application filed after June 7, 1995 but prior to May 29, 2000) holding that the patent term extension is 0 days is requested.

Briefly the law applicable to patent applications filed in April 2000 provided for extension of the patent term for delays due to appellate review and the present application was under appellate review for a period of 303 days for which the patent term should be extended.

The applicable provision of 35 U.S.C. 154(b)(2), (3) and (4) provided:

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“(2) EXTENSION FOR APPELLATE REVIEW.-If the issue of a patent is delayed due to appellate review by the Board of Patent Appeals and Interferences or by a Federal court and the patent is issued pursuant to a decision in the review reversing an adverse determination of patentability, the term of the patent shall be extended for a period of time but in no case more than 5 years. A patent shall not be eligible for extension under this paragraph if it is subject to a terminal disclaimer due to the issue of another patent claiming subject matter that is not patentably distinct from that under appellate review.

(3) LIMITATIONS.-The period of extension referred to in paragraph (2)-

(A) shall include any period beginning on the date on which an appeal is filed under section 134 or 141 of this title, or on which an action is commenced under section 145 of this title, and ending on the date of a final decision in favor of the applicant;

(B) shall be reduced by any time attributable to appellate review before the expiration of 3 years from the filing date of the application for patent; and

(C) shall be reduced for the period of time during which the applicant for patent did not act with due diligence, as determined by the Commissioner.

(4) LENGTH OF EXTENSION.-The total duration of all extensions of a patent under this subsection shall not exceed 5 years.”

37 CFR 1.701(c)(3) sets forth the calculation of the period of extension time as follows:

(3) The period of delay under paragraph (a)(3) of this section is the sum of the number of days, if any, in the period beginning on the date on which an appeal to the Board of Patent Appeals and Interferences was filed under 35 U.S.C. 134 and ending on the date of a final decision in favor of the applicant by the Board of Patent Appeals and Interferences or by a Federal court in an appeal under 35 U.S.C. 141 or a civil action under 35 U.S.C. 145.

It is clear that none of the limitations to the period of extension time apply as set forth in 37 CFR 1.701(d):

“(d) The period of delay set forth in paragraph (c)(3) shall be reduced by:

(1) Any time during the period of appellate review that occurred before three years from the filing of the first national application for patent presented for examination; and

(2) Any time during the period of appellate review, as determined by the Director, during which the applicant for patent did not act with due diligence. In determining the due diligence of an applicant, the Director may examine the

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facts and circumstances of the applicant's actions during the period of appellate review to determine whether the applicant exhibited that degree of timeliness as may reasonably be expected from, and which is ordinarily exercised by, a person during a period of appellate review."

A first Notice of Appeal was filed in this application on February 18, 2004 and this first period of appeal review was ended 154 days later by the mailing of the 5th Office Action on July 21, 2004 . A second Notice of Appeal was filed on July 18, 2005 and this second period of appeal review was ended 149 days later by the mailing of a Notice of Allowance on December 14, 2005. Thus the total period of appeal review is 303 days.

Accordingly it is requested that the patent term in the present application be extended for 303 days.

Respectfully submitted,

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